

of original Claim 1, formulas II and III of original Claim 3, and the particle size of original Claim 11. Support for new dependent Claims 45-51 is found in the original Claims. Support for new claim 52 is found on page 5, lines 8-13. Support for new Claim 53 is found on page 5, line 14. Support for new Claim 54 is found on page 8, lines 29-31. Claims 55 and 56 are new independent claims that include subject matter identified as allowable by the Examiner. Support for new Claims 55 and 56 is found in original Claims 1, 3 and 8, and 1, 3 and 9, respectively. No new matter is added.

REQUEST FOR RECONSIDERATION

Applicants thank Examiner Hendrickson for the indication that Claims 8 and 9 are allowable if rewritten to include the limitations of Claims 1 and 3. New independent Claims 55 and 56 contain the limitations of original Claims 1, 3 and 8, and 1, 3 and 9 respectively.

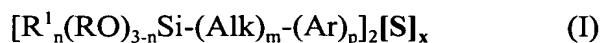
Applicants thank Examiner Hendrickson for the helpful and courteous discussion of March 28, 2002 and the helpful telephone discussion of September 27, 2002 indicating that the submission of a supplementary response canceling the claims added in the Amendment and Request for Reconsideration filed August 7, 2002, is the preferred action for continuing prosecution of the originally elected claims.

The present application includes a description of pulverulent rubber adsorbents useful for absorbing hydrocarbon based materials. The presently claimed pulverulent rubbers are particularly suitable for the adsorption of nonpolar organic compounds that are poorly soluble in water (page 9, lines 11-12).

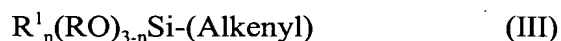
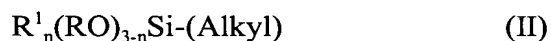
The presently claimed adsorbents contain pulverulent rubber which contains one or more fillers treated with a silicon-containing material. Pulverulent rubber compositions

containing fillers as presently claimed are not disclosed or suggested by the prior art relied upon by the Examiner.¹

The Wolff et al patent discloses mixtures of chemically modified fillers with various materials. The materials used to modify the fillers in Wolff contain sulfur and are of the following formula wherein the [S] group is a sulfur-containing group (see Formula I of the patent; column 1, line 59).



Present Claim 1 has been amended to include only organosilicon groups of formula (II) and (III).



Unlike the materials of the Wolff patent, the presently claimed organosilicon groups do not contain sulfur. Fillers modified with organosilicon groups of present formulas (II) and (III) are not disclosed or suggested in Wolff.

Applicants respectfully request the withdrawal of the rejections under 35 U.S.C. §102(b) and 35 U.S.C. §103(a) in view of Wolff et al.

Claims 1-5, 10-12, 21 and 22 were rejected under 35 U.S.C. §102(e) as anticipated or in the alternative as obvious under 35 U.S.C. §103(a) in view of a patent to Goerl et al (U.S. Patent No. 6,340,724).

¹ Claims 1, 3-5, 12, 21 and 22 were rejected under 35 U.S.C. §102(b) as anticipated by, or in the alternative as obvious over, 35 U.S.C. §103(a) in view of a patent to Wolff et al (U.S. Patent No. 5,116,886).

The present application (09/580,526) and U.S. Patent No. 6,340,724 (Goerl et al.) were commonly owned at the time the invention of application 09/580,526 was made. The Goerl reference is therefore disqualified as prior art under 35 U.S.C. §102(e)/35 U.S.C. §103.² Applicants respectfully request the withdrawal of the rejection under 35 U.S.C. §102(e)/35 U.S.C. §103.

The amendment to the claims obviates the rejections under 35 U.S.C. §112.

In the Office Action it is stated that Applicants did not distinctly and specifically point out the errors in the restriction requirement. Applicants note that the amendment and Response to Restriction and Election Requirement, submitted to the Office on October 17, 2001, contained a detailed traversal of the restriction requirement on page 2, line 13 through page 4, line 11. A Supplemental Restriction Response and Amendment, filed with the Office on November 29, 2001, affirmed the election made in the prior response. Applicants submit that the Response to Restriction Requirement submitted to the Office on October 17, 2001, sufficiently traversed the restriction requirement and hence the election should be treated as an election with traverse.

An Information Disclosure Statement was submitted to the Office on August 30, 2000, together with a Form PTO-1449. A signed and initialed copy of the Form PTO-1449 was not returned with the Office Action of February 7, 2002. Applicants respectfully request that a signed and initialed copy of the Form PTO-1449 be returned with the next

²Effective November 29, 1999, subject matter which was prior art under former 35 U.S.C. § 103 via 35 U.S.C. § 102(e) is now disqualified as prior art against the claimed invention if the subject matter and the claimed invention "were, at the time the invention was made, owned by the same person or under an obligation of assignment to the same person." MPEP §706.02(l)(1).

communication from the Office. A copy of the Form PTO-1449 is attached herewith for the Examiner's convenience.

REQUEST FOR REJOINDER

Claims 13-20, drawn to a process of using the composition of original Claim 1, were restricted out by the Examiner. Applicants respectfully request the Examiner rejoin non-elected Claims 13-20 after determining that the presently active claims to a product are allowable. Process Claims 13-20 are directly or indirectly dependent from original Claim 1 (now Claim 44) and include all the limitations of the product claim (MPEP 706.02(n)).

It is respectfully submitted that the amendment to the claims places all claims in condition for allowance. Applicants thus respectfully request the withdrawal of the outstanding rejections, and the passage of all now pending claims to Issue.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Norman F. Oblon
Attorney of Record
Registration No. 24,618

Stefan U. Koschmieder, Ph.D.
Registration No. 50,238



22850

(703) 413-3000
Fax #: (703) 413-2220
SUKOS/rac
I:\atty\SUKOS\192376US-AM2.wpd

Marked-Up Copy

Serial No: 09/580,526

Amendment Filed on:

Herewith

IN THE CLAIMS

--13. (Amended) A process, comprising:

adsorbing at least one organic compound with the adsorbent as claimed in Claim 44

[1].--

Claims 23-43 (Canceled).

Claims 45-56 (Newly Added).